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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,342	11/08/2001	Mathew Richard Palmer	7310-259	5164

7590 03/18/2004  
PENNIE & EDMONDS LLP  
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EXAMINER

FUNK, STEPHEN R

ART UNIT PAPER NUMBER

2854

DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/986,342

**Applicant(s)**

PALMER ET AL.

**Examiner**

Stephen R Funk

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 16-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-12, 16-18 and 21-26 is/are rejected.
- 7) ☒ Claim(s) 19, 20 and 27-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

The means plus function language utilized in the claims invokes 35 U.S.C. 112, sixth paragraph, and is being interpreted to cover structure on two opposing sides of a cassette that would allow the cassette to be attached to an identical cassette. Although the claims refer to an inferentially recited identical cassette to more clearly describe the claimed invention, this limitation is not deemed to confuse the scope of the claims as it merely clarifies the location of the means on the one positively recited cassette.

Claims 12 and 25 are objected to because of the following informalities:

In claim 12 lines 3 - 4 "a second cassette" is inconsistent in terminology with "an identically shaped cassette" in claim 8 line 2. It appears that that these recitations are referring to the same cassette.

In claim 25 line 1 "The more than two cassettes" lacks proper antecedent basis. There is no positive recitation of more than two cassettes in claim 23 since that claim only recites that the cassette *can* have more than two cassettes "attachable" thereto. To positively recite more than two cassettes they must be literally "attached" to each other. Furthermore, the preamble must clearly reflect what is being recited; if more than one cassette is positively recited the preamble must recite more than one cassette.

Appropriate correction is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8 - 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Wouters et al. ('298). Wouters et al. teach a cassette comprising a supply (S<sub>s</sub>) of image receiving tape (R) and a case (P) having means (41, 63) for attaching the case an identically shaped case. See the paragraph bridging columns 9 and 10 and Figures 4 and 5 of Wouters et al. The broad recitation of an "image receiving" tape does not distinguish from the ribbon of Wouters et al. as a thermal ribbon maintains an image on the ribbon due to the dye being transferred to a receiver. With respect to claim 11 the recesses and projections of Wouters et al. are considered to be "generally" rectangular in cross section.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 - 12, 16 - 18, and 21 - 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murata et al. ('808) in view of Herberger.

Murata et al. teach a cassette comprising an outer case (12), a supply of image receiving tape (25), pins (28, 29, 31, 32) for guiding the tape, and an outlet (not labeled) to allow the tape to exit the case. Note the means (43) for attaching the cassette to a tape printer. See the paragraph bridging columns 5 and 6 and Figures 5 and 6 of Murata et al. Murata et al. do not teach that the means for attaching (43) may be utilized to attach the case to an identically shaped case.

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Herberger teaches the desirability of utilizing a functional projection (29) on a case (1) to not only interact with the machine the case is inserted into but also to aid in attaching, stacking, shipping, and storing of like cases. See the entire document of Herberger, in particular, column 2 lines 29 - 33 and column 3 lines 29 - 45.

It would have been obvious to one of ordinary skill in the art to provide the case of Murata et al. with means, in the form of a corresponding recess, in view of Herberger so as to aid in storing and shipping the cassettes.

With respect to claims 9, 23, and 25 Herberger teaches that the cartridge could be attached to plural alike "cartridges".

With respect to claims 10 and 18 it would have been obvious to one of ordinary skill in the art to provide the top of the case of Murata et al. with a recess to match the projection on the bottom of the case of in view of Herberger to provide the desired attaching and stacking of the cases.

With respect to claims 11 and 26 the upstanding portion (43) of Murata et al. is "generally rectangular". However, note column 6 lines 39 - 45 of Murata et al. It would have been obvious to one of ordinary skill in the art to provide the upstanding portion of Murata et al. in the shape of a rectangular so long as the corner provides the desired function of cooperating with the rollers (44, 45).

With respect to claims 12 and 21 note the zone/slot (46) of Murata et al.

With respect to claim 17 note the walls of Murata et al.

With respect to claim 22 note column 6 lines 26 - 31 of Murata et al.

With respect to claim 24 it would have been obvious to one of ordinary skill in the art through routine experimentation to provide the upstanding projection with a height one-third the height of the cassette.

Claims 19, 20, and 27 - 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed January 8, 2004 have been fully considered but they are not persuasive. With respect to Wouters et al., the prior art rejection has been clarified by identifying the case as package (P), not the cassette (C). Applicant's argument that the package (P) of Wouters et al. does not meet the definition of a "cassette" (as defined by the American Heritage College Dictionary, Third Edition, 1997) is not persuasive since applicant's cassette does not meet that definition. Note that applicant's cassette does not have two reels or photographic film. With respect to the combination of Murata et al. and Herberger, the cassette and cartridge of Murata et al. and Herberger, respectively, are deemed to be related art since both enclose a tape like medium. Furthermore, the specific teaching by Herberger to utilize an essential functional feature for stacking is particularly relevant to the functional projection of Murata et al. The projection of Murata et al. inherently causes a problem of stacking and Herberger teaches the desirability of using such a projection to facilitate stacking.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

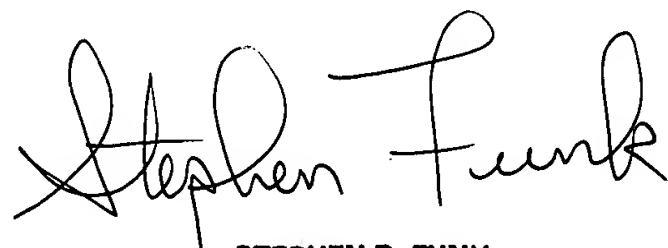
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen R. Funk whose telephone number is (571) 272-2164. The examiner can normally be reached M - F, except Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (571) 272-2168.

The fax phone number for ALL official papers is (703) 872-9306. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner at (571) 273-2164.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

SRF  
March 9, 2004



**STEPHEN R. FUNK**  
**PRIMARY EXAMINER**